

### **REMARKS**

These remarks are in response to the Office Action having a mail date of December 3, 2007. This response is timely filed. At the time of the Office Action, claims 29-40 were pending in the application.

#### **I. Status of the Claims**

Claim 36 and 40 were cancelled without prejudice or disclaimer of the subject matter therein. Claims 29-31, 34, 35, and 39 have been amended. No new matter was added. Claims 41-51 have been added.

Claim 36 was objected to for informalities. Claims 30 and 40 were rejected under 35 U.S.C. §112. Claims 29-40 were rejected on the grounds of non-statutory obviousness-type double patenting. Claims 29-33 and 35-40 were rejected under 35 U.S.C. §102(b). Claim 34 was rejected under 35 U.S.C. §103(a). The objections and rejections are set out in more detail below.

#### **II. Claim Objection**

In the Office Action, the Examiner objected to claim 36 because of informalities. More particularly, the Examiner objected to claim 36 because the phrase “to be break” is unclear. Applicant has cancelled claim 36. As such, the Examiner’s rejection is moot.

#### **III. Claim Rejections Under 35 U.S.C. §112**

In the Office Action, the Examiner rejected claims 30 and 40 under 35 U.S.C. §112. More particularly, the Examiner rejected claims 30 because there is insufficient antecedent basis for the limitation “said tip” in line 2. Applicant has amended claims 30 to overcome this rejection.

The Examiner has rejected claim 40 because there is insufficient antecedent basis for the limitation “the apparatus” in line 1. Applicant has cancelled claim 40. As such, the Examiner’s rejection of claim 40 is moot.

#### IV. Double Patenting

Claims 29-40 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 7,174,681 to Robert J. Wilson (hereinafter "the '681 patent"). More particularly, claims 29-34 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23, 24, 25, and 27 the '681 patent. Claims 37-39 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23, 28, 29 of the '681 patent. Claims 35, 36, and 40 were rejected under the judicially created doctrine of obviousness-type double patenting as being inherent to the structure claimed in the '681 patent.

A terminal disclaimer in accordance with 37 C.F.R. §1.321(c) is enclosed to overcome this rejection. Also enclosed is a Statement Under 37 C.F.R. § 3.73(b). Accordingly, withdrawal of the obviousness-type double patenting rejection is respectfully requested. Please charge the fee associated with filing the Terminal Disclaimer to the credit card ending in 21009.

#### V. Claim Rejections Under 35 U.S.C. §102(b)

Claims 29-33 and 35-40 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,926,785 to Lamson (hereinafter "the '785 patent"). Applicant respectively traverses the rejections. In response to the Examiner's rejection of claims 29-33 and 35-40 based on 35 U.S.C. §102(b), Applicant has amended claims 29-31, 34, 34, and 39 to recite the structure of the claimed apparatus with greater clarity. Applicant has also canceled claims 36 and 40. As such, the Examiner's rejections to claims 36 and 40 are moot.

The '785 patent generally discloses a marker for golf courses. *See* Abstract and FIGS. 1-3. The marker 10 is comprised of a hollow plastic shaft 10, a decorative cap 24, a receptacle 12, and a surface plate 14. The decorative cap 24 is configured to be inserted into a top end portion of the hollow plastic shaft 10. A bottom end portion of the hollow plastic shaft 10 is configured to be inserted into the receptacle 12. The surface plate 14 has a central aperture sized and shaped for receipt of the receptacle 12. The surface plate 14 is configured so that a golf ball will not come to rest next to the marker.

The '785 patent also discloses a hole marker 42 for installing the marker. See FIG. 4. The hole marker 42 is comprised of a steel pipe 28, a roll pin 40, and a steel piercing point 30. The steel piercing point 30 is attached to a bottom end portion of the steel pipe 28 via the roll pin 40. As such, bottom end portion of the steel pipe 28 has an aperture formed therein sized and shaped for receiving the roll pin 40.

Notably, the '785 patent fails to disclose and/or teach the apparatus of claim 29 and the disposable stake of claim 39. More particularly, the '785 patent fails to disclose and/or suggest a stake comprising an elongated body having an upper portion with a frangible section separable from a remainder of said elongated body at a location defined by at least one break-point where the elongated body is modified to provide a reduced shear strength as compared to a remainder of the elongated body. Rather, the '785 patent discloses a hollow shaft 10 and a steel pipe 28 with a bore formed on a lower portion for securing a head thereto. Notably, both of these structures 10, 28 do not have an upper portion that includes a frangible section separable from an elongated body at a location defined by a break-point.

In view of the forgoing, the '785 patent fails to disclose and/or suggest the apparatus of claim 29 and the disposable stake in claim 39. Accordingly, Applicant requests re-consideration and allowance of the independent claims 29 and 39. Claims 30-35, 37, and 38 are believed to be allowable at least by virtue of their dependence on an allowable base claim 29. As such, Applicant also requests re-consideration and allowance of claims 30-35, 37, and 38.

#### VI. New Claims

Claims 41-48 are believed to be allowable at least by virtue of their dependence on an allowable base claim 39. Claims 49-51 distinguish over the cited art of record based at least on the argument presented above in relation to the Examiner's rejections of claims 29-33 and 35-40 under 35 U.S.C. §102(b).

#### VII. Claim Rejections Under 35 U.S.C. §103(a)

Claim 34 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the '785 patent. In this regard, the Examiner remarks that the '785 patent does not disclose a bore passing

through the stake. However, the '785 patent discloses a bore passing through the disclosed digging tool for securing a head to a lower end portion thereof. As such, the Examiner opines that it would have been obvious to a person skill in the art at the time of the invention was made to modify the '785 patent by using the bore and pin on the stake to secure the stake head in order to better secure it from separating the stake.

Notwithstanding the Examiner's remarks, Applicants assert that the bore disclosed in the '785 patent is not equivalent to the bore(s) of the present invention. The '785 patent also fails to disclose a frangible upper portion as claimed. Therefore, it would not have been obvious to a person skilled in the art to create the stake structure of claim 34 in view of the '785 patent. In this regard, it should be understood that the bore(s) of the present invention are advantageously located on an upper portion of the stake and are designed to define a break-point for facilitating the removal of an upper frangible portion. In contrast, the bore of the '785 patent is located on a lower portion of the digging tool and does not disclose a frangible portion. It should also be understood that the bore(s) of the present invention are provided for securing a concrete form to the stake via a fastening device and defining a break-point. In contrast, the bore of the '785 patent is provided for securing a head to a bottom end portion of the digging tool via a fastening device. There is no suggestion that the bore provided in the '785 patent could define a break point for a frangible section.

It should further be noted that claim 34 depends on independent claim 29. As discussed above, the '785 patent fails to disclose and/or suggest the apparatus of claim 29. More particularly, the '785 patent fails to disclose and/or suggest a stake comprising an elongated body having an upper portion with a frangible section separable from the elongated body at a location defined by at least one break-point where the elongated body is modified to provide a reduced shear strength as compared to a remainder of the elongated body. Rather, the '785 patent discloses a hollow shaft 10 and a steel pipe 28 with a bore formed on a lower portion for securing a head thereto. Notably, both of these structures 10, 28 do not have an upper portion that includes a frangible section separable from an elongated body at a location defined by a break-point.

In view of the forgoing, the '785 patent fails to disclose and/or teach the apparatus recited in base claim 29 and dependant claim 34. Accordingly, Applicant requests re-consideration and allowance of claim 34 at least by virtue of its dependence on the allowable base claim 29.

VIII. Conclusion

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition of allowance. Nevertheless, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. In view of the foregoing remarks, Applicants respectfully request reconsideration and prompt allowance of the pending claims.

Dated: February 28, 2008

Respectfully submitted,

By 

Robert J. Sacco

Registration No.:

DARBY & DARBY P.C.

P.O. Box 770

Church Street Station

New York, New York 10008-0770

(212) 527-7700

(212) 527-7701 (Fax)

Attorneys/Agents For Applicant